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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 46354.010200

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 28, 2005

Signature: Paul R. Mahan

Typed or printed name: Paul R. Mahan

Application Number	Filed
09/663,281	September 15, 2000

First Named Inventor: Winston Donald KEECH

Art Unit	Examiner
2692	SON, Linh L. D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 50,851
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Typed or printed name

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Telephone number

November 28, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

Atty. Docket No: 46354.010200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: :
KEECH, Winston Donald : Group Art Unit: **2135**
Serial No.: **09/663,281** : Examiner: **SON, Linh L. D.**
Filed: **September 15, 2000** :
For: **Embedded Synchronous Random Disposable Code Identification Method and System**

LETTER SUBMITTING REMARKS WITH PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

This paper is being filed with a Pre-Appeal Brief Request for Review and a Notice of Appeal and summarizes Applicants' arguments in the Response under 37 CFR 1.116 filed on even date herewith. Applicants assert that the filing of the Pre-Appeal Brief Request for Review is appropriate at this time as no amendments are included in the Response.

REMARKS/ARGUMENTS

Applicants seek formal review by a panel of examiners of the 35 U.S.C.§ 103(a) rejection of the claims raised in a first Office Action mailed on February 9, 2005, which rejection was made final in a second Office Action mailed on July 27, 2005. Review of the § 103(a) rejection based on a combination of Bostley, III et al, U.S. Patent No. 6,201,871B1 (referred to herein as "Bostley"), in view of Cardano Grilles (referred to herein as "Grilles") is requested.

In maintaining the Examiner's earlier rejections, the Examiner asserts that Applicants' arguments filed May 9, 2005 have been fully considered but are not persuasive. The arguments made by the Examiner in dismissing Applicants' arguments are inconsistent, contradictory, and contrary to well-settled law. On page 3, the Examiner does not dispute that Bostley teaches away from Applicants' claimed invention, yet the Examiner asserts that "Nevertheless, as recited in the previous rejection...It is clearly and obvious [sic] for one having ordinary skill in the art at the time of the invention was made [sic] to modify Bostley's invention to implement the Grille technique...". The Court of Appeals for the Federal Circuit has consistently held that it is "error

to find obviousness where references 'diverge from and teach away from the invention at hand'."(emphasis added) In re Fine, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988) . The Examiner's continued reliance on the combination of Bostley and Grilles is therefore clear error. The Examiner's position is contrary to the well-settled law in this area, and therefore should be reversed.

The Examiner also admits that "it is obvious the overlay technique in Grille can not be applicable in the technological art" (emphasis added) (Office Action, p. 2), but then takes the position that it would be obvious to one skilled in the art to "intelligently transform the technique into an electronic operation" (Office Action, p. 2). In so doing, the Examiner has taken two contradictory points of view with respect to Grilles in the span of two sentences. Similarly, the Examiner's position later in the Office Action is contradictory to the Examiner's own earlier assertions. As described above, the Examiner asserts that "it is obvious the overlay technique in Grille can not be applicable in the technological art." If this is the case, it is improper for the Examiner to then assert that "it is clearly and obvious [sic] for one having ordinary skill in the art at the time of the invention was made [sic] to modify Bostley's invention to implement the Grille technique..." (Office Action, page 3). Applicant agrees with the Examiner that Grilles is not "applicable in the technological art" (Office Action, page 2), and asserts therefore that one skilled in that same technological art would be motivated to make the combination suggested by the Examiner, or to "intelligently transform the technique into an electronic operation". Therefore the Examiner's continued rejection under these grounds should be reversed.

Still further, the Examiner fails to provide any motivation, absent the hindsight provided by Applicants' invention, as to why one skilled in the art would seek to modify Grilles, especially in light of the fact that Grilles "can not be applicable in the technological art" in the first place. Applicants assert that the Examiner's rejection is based on hindsight, and that the Examiner's determination of obviousness is without a specific motivation within the cited references or, if the Examiner is relying on general knowledge of the art, that the Examiner's rejection is not capable of readily documented substantiation. The Examiner has not provided any findings that, absent hindsight, even suggest the modifications to Grilles relied upon by the Examiner in sustaining the rejection other than the blueprint drawn by Applicants in the instant patent application, and Applicants respectfully request that the Examiner's rejection be reversed.

Applicants also assert that combining Grilles and Bostley is inoperable for the intended purpose recited in Grilles. It is generally settled law that a change in a prior art device which makes the device inoperable for its intended purpose cannot be considered to be an obvious change. In the instant Office Action, modifying Grilles in a manner consistent with Bostley as suggested by the Examiner would render Grilles inoperable for its intended purpose. Applicants therefore respectfully request that the Examiner's rejection be reversed.

Furthermore, even if, arguendo, the combination of references relied on by the Examiner met all of the other legal requirements, the Examiner still fails to recognize that the prior art relied upon by the Examiner does not teach all elements of Applicants' claimed invention. Applicants have attempted to call to the Examiner's attention the structural differences between the claimed invention and the prior art, but the Examiner has ignored those differences. In Grilles, the characters are read through the holes in the cardboard overlay in sequential order. Moreover, in Grilles, a message must first be written through the appropriate holes in the cardboard overlay before the remaining squares are populated with letters. This means that Grilles inherently does not use, nor can it use, a pseudo-random string as recited in Applicants' claims. Unlike Grilles, where the underlying message is predetermined, in Applicants' invention the volatile identification is not predetermined, but rather is generated by applying the "mask code" to the pseudorandom string. The Examiner's failure to fully appreciate the distinctions between the claimed invention and the prior art has resulted in the Examiner improperly maintaining the rejection, and the Examiner's rejection should be reversed.

Respectfully submitted,

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